

Appln. No. 10/065,970
Docket No. GEM-0066 / 126995

REMARKS / ARGUMENTS

Status of Claims

Claims 1-31 are pending in the application. Claims 1-26 stand rejected. Claims 27-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates the Examiner's comments regarding the allowability of the noted claims. Applicant has amended Claim 28 to correct for an obvious typographical error, leaving Claims 1-31 for consideration upon entry of the present Amendment.

Applicant respectfully submits that the rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

Rejections Under 35 U.S.C. §102(b)

Claims 1-3, 9-11, 17-18, 20 and 26 stand rejected under 35 U.S.C. §102(b) as being anticipated by Jenness et al. (U.S. Patent No. 5,373,300, hereinafter Jenness).

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*" *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the *** claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, the single source must disclose all of the claimed elements "*arranged as in the claim.*" *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984) (emphasis added). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of

Appn. No. 10/065,970
Docket No. GBM-0066 / 126995

another reference. Titanium Metals Corp. v. Banner, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

At the outset, Applicant notes that the Examiner has repeated the same reasons for rejection that were presented in the previous office action, and further states: "As shown on the drawing that a portion of the cable 21, 30 being removably disposed in and removably secured by the channel 38. One can assumed (sic) that the channel [is] for temporary storing the cable." Final Action Paper No. 0304, pages 2 and 5.

Applicant also notes that the Examiner uses the same paper number 0304 for the September 2, 2005 Final Office Action that was used for the April 18, 2005 Non-Final Office Action. Accordingly, Applicant herein refers to the instant office action as "Final Action Paper No. 0304".

Regarding Claims 1-3

Claim 1 recites, inter alia, "... a portion of the cable being removably disposed in and removably secured by the channel for temporarily storing the cable." (Emphasis added). Dependent claims inherit all of the limitations of the parent claim.

Applicant respectfully disagrees that Jenness discloses *each and every element arranged and claimed*. More specifically, Applicant submits that Jenness fails to disclose a portion of the cable being removably disposed in and removably secured by the channel for temporarily storing the cable.

In rejecting the instant invention on grounds of anticipation, the Examiner states that "*As shown on the drawing* that a portion of the cable 21, 30 being removably disposed in and removably secured by the channel 38. One can assumed (sic) that the channel [is] for temporary storing the cable." (Emphasis added) Final Action Paper No. 0304, pages 2 and 5.

First, the Examiner does not state with specificity which drawing of Jenness shows a portion of the cable 21, 30 being removably secured by the channel, and Applicant does not find such a disclosure in any of the Jenness drawings.

Second, the Examiner admits that an assumption is required in order to arrive at the arrangement of claim elements being arranged for temporary storing of the cable.

Appin. No. 10/063,970
Docket No. GBM-0066 / 126995

Applicant submits that without actual disclosure of each and every element of the claimed invention arranged as claimed, the use of an assumption is improper for purposes of anticipation.

Third, the Examiner refers to Jenness elements 21 and 30 as disclosing the claimed cable, when Jenness specifically discloses element 21 as being a coaxial cable and element 30 as being an antenna. Column 4, lines 13-14. Thus, Applicant submits that Jenness does not disclose each and every element of the claimed invention arranged as claimed.

In view of at least the foregoing, Applicant submits that Jenness falls wholly short of anticipatory disclosure of the claimed invention.

If the Examiner is referring to Jenness Figure 1 in an effort to show "a portion of cable 21, 30 being removably disposed in and removably secured by the channel 38", as alleged, then Applicant respectfully disagrees.

In Jenness Figure 1, Applicant finds an external antenna 20 being coupled by a coaxial cable 21 to a keyboard 14 of a computer 12, which is described in Column 3, lines 23-50, and Column 4, lines 5-14. Accordingly, and with reference still to Jenness Figure 1, cable 21 appears to be outside of any channel and to be merely a coupling between computer 12 and antenna 20. Hence, Applicant submits that in Jenness Figure 1, cable 21 is not disclosed being removably disposed in and removably secured by a channel, as specifically claimed for in the instant invention.

Furthermore, in Jenness Figure 1, Applicant finds antenna elements 30 to be disposed within external antenna 20, which is described in Column 3, lines 47-50. Accordingly, and with reference still to Jenness Figure 1, antenna elements 30 appear to be fixed within external antenna 20. Hence, Applicant submits that in Jenness Figure 1, antenna elements 30 are not disclosed being removably disposed in and removably secured by a channel, as specifically claimed for in the instant invention.

If the Examiner is referring to Jenness Figure 2 in an effort to show "a portion of cable 21, 30 being removably disposed in and removably secured by the channel 38", as alleged, then Applicant respectfully disagrees.

Appln. No. 10/065,970
Docket No. GEM-0066 / 126995

In Jenness Figure 2, Applicant finds a display 16 having a cable 21 and antenna elements 30 disposed thereabout, which is described at Column 4, lines 5-14, and finds no disclosure of a channel as claimed. Accordingly, and with reference still to Figure 2, cable 21 and antenna elements 30 appear to be disposed about display 16 only in a general manner, and not in a removably disposed or secured manner. Hence, Applicant submits that in Jenness Figure 2, cable 21 and antenna elements 30 are not disclosed being removably disposed in and removably secured by a channel, as specifically claimed for in the instant invention.

If the Examiner is referring to Jenness Figure 3 in an effort to show "a portion of cable 21, 30 being removably disposed in and removably secured by the channel 38", as alleged, then Applicant respectfully disagrees.

In Jenness Figure 3, Applicant finds an antenna element 30 having a ground plan 44, an insulator 46 and a mounted antenna element 48, disposed within a tubular member 38, which is described at Column 4, lines 15-33. Accordingly, and with reference still to Figure 3, antenna element 30 (including 44, 46 and 48) appears to be captivated within tubular housing 38. Hence, Applicant submits that in Jenness Figure 3, antenna element 30 is not disclosed being removably disposed in and removably secured by a channel, as specifically claimed for in the instant invention.

If the Examiner is referring to some other Figure of Jenness in an effort to show "a portion of cable 21, 30 being removably disposed in and removably secured by the channel 38", as alleged, then Applicant respectfully requests the Examiner to specifically identify such Figure.

Furthermore, Jenness Figure 3 discloses an adhesive 42 for mounting tubular member 38 to display 16, which is discussed at Column 4, lines 22-28. Here, Applicant finds Jenness to disclose a means for *permanently* attaching external antenna 20, containing antenna elements 30, to display 16, and not a means for *removably* retaining and *removably* securing antenna elements 30 by a channel.

The Examiner remarks that the finality of the rejection is proper because "*As shown on the drawing*" that a portion of the cable 21, 30 being removably disposed in and

Appin. No. 10/065,970
Docket No. GEM-0066 / 126995

removably secured by the channel 38. One can assumed (sic) that the channel [is] for temporary storing the cable." (Emphasis added) Final Action Paper No. 0304, pages 2 and 5.

Applicant respectfully disagrees, and in view of the foregoing remarks, Applicant respectfully submits that the Examiner has not shown with specificity where the drawings support the allegation of anticipation, that such a lack of support falls wholly short of meeting the burden of showing where each and every element of the claimed invention arranged as claimed is disclosed, and therefore submits that the finality of the rejection is improper, and respectfully requests removal of the finality of the rejection with a full explanation of where the drawings, or any other part of Jenness, fully support the allegation of anticipation.

Absent anticipatory disclosure in Jenness of each and every element of the claimed invention arranged as in the claim, Jenness cannot be anticipatory, and Applicant respectfully submits that the Examiner has failed to meet the burden of showing such anticipation.

Regarding Claims 9-11

Claim 9 recites, inter alia, "... contact surfaces integral to the housing configured to releasably secure the portion extending from the housing to the housing." Thus, the cable portion extending from the housing is claimed to be releasably secured to the housing by contact surfaces integral to the housing. Dependent claims inherit all of the limitations of the parent claim.

The Examiner alleges that Jenness anticipates *each and every element* of the claimed invention *arranged as claimed* including the aforementioned limitation. Final Action Paper No. 0304, page 2 (Emphasis added).

Applicant respectfully disagrees.

In comparing Jenness with the instant invention, Applicant finds Jenness to be absent any disclosure of contact surfaces integral to the housing configured to releasably secure the portion of the cable extending from the housing to the housing, and the

Appn. No. 10/065,970
Docket No. GEM-0066 / 126995

Examiner has not stated with specificity where Jenness does provide such disclosure of the claimed elements *arranged as claimed*.

In the instant Final Action, Applicant finds no reference to each and every element of Claim 9. Accordingly, Applicant submits that the finality of the rejection is improper, and respectfully requests removal of the finality of the rejection with a full explanation of where Jenness discloses each and every element of the claimed invention arranged as claimed.

Absent anticipatory disclosure in Jenness of each and every element of the claimed invention arranged as in the claim, Jenness cannot be anticipatory, and Applicant respectfully submits that the Examiner has failed to meet the burden of showing such anticipation.

Regarding Claims 17-18

Claim 17 recites,

"A method of storing a cable in a monitoring device, the method comprising:
extending a cable to reduce an outside diameter of the cable to less than a width of a channel formed in the monitoring device;
disposing *the extended cable* in the channel; and
releasing the extended cable to secure the cable within the channel."

Dependent claims inherit all of the limitations of the parent claim.

The Examiner alleges that Jenness anticipates *each and every element* of the claimed invention *arranged as claimed* including *all* of the aforementioned method limitations. Final Action Paper No. 0304, page 2 (Emphasis added).

Applicant respectfully disagrees.

In comparing Jenness with the instant invention, Applicant finds Jenness to be absent any disclosure of *a method of storing a cable* in a monitoring device *according to the claimed invention*, where each and every element of the claimed invention must be considered.

More specifically, Applicant finds Jenness to be absent any disclosure of *extending a cable to reduce an outside diameter of the cable to less than a width of a*

Appln. No. 10/065,970
Docket No. GEM-0066 / 126995

channel formed in the monitoring device, to be absent any disclosure of disposing *the extended cable* in the channel, and to be absent any disclosure of *releasing the extended cable to secure the cable within the channel*, and the Examiner has not stated with specificity where each and every element of the claimed invention may be found in Jenness.

In the instant Final Action, Applicant finds no reference to each and every element of Claim 17. Accordingly, Applicant submits that the finality of the rejection is improper, and respectfully requests removal of the finality of the rejection with a full explanation of where Jenness discloses each and every element of the claimed invention arranged as claimed.

Absent anticipatory disclosure in Jenness of each and every element of the claimed invention arranged as in the claim, Jenness cannot be anticipatory, and Applicant respectfully submits that the Examiner has failed to meet the burden of showing such anticipation.

Regarding Claim 20

Claim 20 recites, inter alia,

"...a portion of the cable being *removably disposed* in the channel."

Dependent claims inherit all of the limitations of the parent claim.

The Examiner alleges that Jenness anticipates *each and every element* of the claimed invention *arranged as claimed* including the aforementioned limitation. Paper No. 0304, page 2 (Emphasis added).

Applicant respectfully disagrees.

In comparing Jenness with the instant invention, Applicant finds Jenness to be absent any disclosure of a portion of the cable being removably disposed in the channel, and the Examiner has not stated with specificity where such disclosure may be found in Jenness.

In the instant Final Action, Applicant finds no reference to each and every element of Claim 20. Accordingly, Applicant submits that the finality of the rejection is improper, and respectfully requests removal of the finality of the rejection with a full explanation of

Appln. No. 10/065,970
Docket No. GEM-0066 / 126995

where Jenness discloses each and every element of the claimed invention arranged as claimed.

Absent anticipatory disclosure in Jenness of each and every element of the claimed invention arranged as in the claim, Jenness cannot be anticipatory, and Applicant respectfully submits that the Examiner has failed to meet the burden of showing such anticipation.

Regarding Claim 26

Claim 26 recites, inter alia,

"...the cable being *removably received* in the channel."

Dependent claims inherit all of the limitations of the parent claim.

The Examiner alleges that Jenness anticipates *each and every element* of the claimed invention *arranged as claimed* including the aforementioned limitation. Paper No. 0304, page 2 (Emphasis added).

Applicant respectfully disagrees.

In comparing Jenness with the instant invention, Applicant finds Jenness to be absent any disclosure of the cable being *removably received* in the channel, and the Examiner has not stated with specificity where such disclosure may be found in Jenness.

In the instant Final Action, Applicant finds no reference to each and every element of Claim 20. Accordingly, Applicant submits that the finality of the rejection is improper, and respectfully requests removal of the finality of the rejection with a full explanation of where Jenness discloses each and every element of the claimed invention arranged as claimed.

Absent anticipatory disclosure in Jenness of each and every element of the claimed invention arranged as in the claim, Jenness cannot be anticipatory, and Applicant respectfully submits that the Examiner has failed to meet the burden of showing such anticipation.

In summary, the Examiner alleges anticipation, but has not shown with specificity where Jenness discloses the following elements arranged as claimed:

Appln. No. 10/065,970
Docket No. GEM-0066 / 126995

"... a portion of the cable being removably disposed in and removably secured by the channel for temporarily storing the cable." (Claim 1).

"... contact surfaces integral to the housing configured to releasably secure the portion extending from the housing to the housing." (Claim 9).

"A method of storing a cable in a monitoring device, the method comprising:
extending a cable to reduce an outside diameter of the cable to less than a width of a channel formed in the monitoring device;

disposing *the extended cable* in the channel; and
releasing the extended cable to secure the cable within the channel." (Claim 17).

"...a portion of the cable being *removably disposed* in the channel." (Claim 20).

"...the cable being *removably received* in the channel." (Claim 26).

Dependent claims inherit all of the limitations of the respective parent claim.

The Examiner remarks that the finality of the rejection is proper because "*As shown on the drawing* that a portion of the cable 21, 30 being removably disposed in and removably secured by the channel 38. One can assumed (sic) that the channel [is] for temporary storing the cable." (Emphasis added) Final Action Paper No. 0304, pages 2 and 5.

However, Applicant respectfully disagrees that a proper showing of anticipation has been made, and in view of the foregoing remarks, Applicant respectfully submits that the Examiner has not shown with specificity where the drawings support the allegation of anticipation, that such a lack of support falls wholly short of meeting the burden of showing where each and every element of the claimed invention arranged as claimed is disclosed, and therefore submits that the finality of the rejection is improper, and respectfully requests removal of the finality of the rejection with a full explanation of where the drawings, or any other part of Jenness, support the allegation of anticipation.

In view of the foregoing remarks, Applicant submits that Jenness does not disclose each and every element of the claimed invention arranged as claimed and

Appln. No. 10/065,970
Docket No. GEM-0066 / 126995

therefore cannot be anticipatory. Accordingly, Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. §102(b) have been traversed, and requests that the Examiner reconsider and withdraw these rejections.

Rejections Under 35 U.S.C. §103(a)

Claims 4-8, 12-16, 19 and 21-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Jenness in view of Doherty et al. (U.S. Patent No. 6,567,277, hereinafter Doherty).

The Examiner alleges that Jenness discloses some elements of the claimed subject matter as set forth above under the 35 U.S.C. §102 rejections, acknowledges that Jenness is deficient in disclosing other elements of the claimed subject matter, and looks to Doherty to cure these deficiencies. Final Action Paper No. 0304, page 3.

Applicant traverses this rejection for the following reasons.

Applicant respectfully submits that the obviousness rejection based on the References is improper as the References fail to teach or suggest each and every element of the instant invention. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

At the outset, Applicant notes that the Examiner has repeated the same reasons for rejection that were presented in the previous office action without further responding to Applicant's remarks that were filed in the Response dated June 20, 2005. In view of the absence of a showing of where the References teach or suggest each and every element of the claimed invention arranged to perform and the claimed invention performs, Applicant submits that the obviousness rejection is improper, that the finality of the instant rejection is improper, and respectfully requests removal of the finality of the instant rejection because the Examiner has not properly met the burden of establishing a prima facie case of obviousness.

Appin. No. 10/065,970
Docket No. GEM-0066 / 126995

Under this obviousness rejection, the Examiner acknowledges that Jenness is deficient, and alleges that Doherty discloses:

"... wherein the cable has *a relaxed outside diameter and a stretched outside diameter*, the relaxed outside diameter being *greater than a width of the channel* and the stretched outside diameter *being less than the width of the channel*... wherein the cable is received in the channel in *press-fit* fashion... further comprising: *a detent formed on a side of the channel*, the detent *releasably retaining* the cable in the channel." Final Action Paper 0304, pages 3-4. (Emphasis added).

Applicant respectfully disagrees that such deficiencies are cured by Doherty.

While the Examiner alleges that Doherty discloses a cable with *a relaxed outside diameter and a stretched outside diameter*, the relaxed outside diameter being *greater than a width of the channel* and the stretched outside diameter *being less than the width of the channel* (Final Action Paper 0304, page 3) (emphasis added), the Examiner does not recite where in Doherty such a disclosure may be found, and Applicant finds no such disclosure in Doherty.

Contrary to the Examiner's allegation, Applicant finds Doherty to teach a cable 16 having *a single relaxed outside diameter* (Figures 1, 2 and 6), and being absent the attribute of having *a relaxed outside diameter greater than a width of the channel 26 and a stretched outside diameter less than the width of the channel 26*. In Doherty, the cable 16 is taught to be wrapped around the channel 26 and secured to the housing 11 by a flexible member 40. Column 3, lines 1-5, and Figure 6. Not only does Applicant find Doherty deficient in teaching *a relaxed outside diameter greater than a width of the channel and a stretched outside diameter less than the width of the channel*, but Applicant also finds Doherty to be deficient in teaching a stretched outside diameter *and* a relaxed outside diameter in and of itself.

While the Examiner alleges that Doherty discloses the cable being received in the channel in *press-fit* fashion (Final Action Paper 0304, page 3) (emphasis added), the Examiner does not recite where in Doherty such a disclosure may be found, and Applicant finds no such disclosure in Doherty.

Appln. No. 10/065,970
Docket No. GEM-0066 / 126995

Contrary to the Examiner's allegation, Applicant finds Doherty to teach the cable 16 being wrapped around the channel 26 and secured to the housing 11 by a flexible member 40. Column 3, lines 1-5, and Figure 6. Not only does Applicant find Doherty deficient in teaching the cable being received in the channel in a *press-fit* fashion, but Applicant also finds Doherty to be teaching just the opposite, namely, securement of the cable by the addition of an auxiliary member (flexible member 40), and not securement of the cable by the absence of an auxiliary member utilizing a press-fit arrangement.

While the Examiner alleges that Doherty discloses *a detent formed on a side of the channel*, the detent *releasably retaining* the cable in the channel (Final Action Paper 0304, page 4) (emphasis added), the Examiner does not recite where in Doherty such a disclosure may be found, and Applicant finds no such disclosure in Doherty.

Contrary to the Examiner's allegation, Applicant finds Doherty to teach the cable 16 being wrapped around the channel 26 and secured to the housing 11 by a flexible member 40. Column 3, lines 1-5, and Figure 6. Not only does Applicant find Doherty deficient in teaching *a detent formed on a side of the channel*, the detent *releasably retaining* the cable in the channel, but Applicant also finds Doherty to be teaching just the opposite, namely, securement of the cable by the addition of an auxiliary member (flexible member 40), and not securement of the cable by the absence of an auxiliary member utilizing a detent formed on a side of the channel.

In contrast to the present invention, Applicant submits that a Doherty flexible member 40 used for securing a Doherty cable 16 in *a wrapped configuration* (Figure 6) is not a disclosure of a cable being *removably disposed in and removably secured by the channel* for temporarily storing the cable, as claimed, that Jenness also fails to disclose this element, and that Doherty fails to cure this deficiency of Jenness.

Regarding Claims 5, 13, 19 and 22 Specifically

Claims 5, 13, 19 and 22 include the limitation of the cable being coiled *in the form of a spring*.

In alleging obviousness by repeating the same reasons for rejection that were presented in the previous office action without further explanation of where Jenness and

Appl. No. 10/065,970
Docket No. GEM-0066 / 126995

Doherty teach or suggest the cable being coiled *in the form of a spring*, Applicant submits that the Examiner has failed to meet the burden of showing a prima facie case of obviousness, and in view thereof, Applicant respectfully requests removal of the finality of the instant rejection so that the Examiner may show where the References teach or suggest each and every element of the claimed invention.

In view of the foregoing, Applicant submits that the References fail to teach or suggest each and every element of the claimed invention and are therefore wholly inadequate in their teaching of the claimed invention as a whole, fail to motivate one skilled in the art to do what the patent Applicant has done, fail to offer any reasonable expectation of success in combining the References to perform as the claimed invention performs, and disclose a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a prima facie case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant considers to be traversed.

In light of the forgoing, Applicant respectfully submits that the proposed arguments comply with 37 C.F.R. §1.116 and should therefore be entered, and with their entry that the Examiner's rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) have been traversed, and that the application is now in condition for allowance. Such action is therefore respectfully requested.

Regarding Allowable Subject Matter

Claims 27-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates the Examiner's comments regarding the allowability of the noted claims.

Claims 27-31 depend from Claim 26, and in view of the foregoing remarks, Applicant submits that Claim 26 is allowable, that Claims 27-31 are therefore also

Appl. No. 10/065,970
Docket No. GEM-0066 / 126995

allowable as being dependent upon an allowable claim, and respectfully requests notice of allowance thereof.

Regarding Claim 28

Applicant has amended Claim 28 to correct for an obvious typographical error. Applicant submits that this amendment is of such a nature that no further search or consideration should be required, and therefore respectfully requests entry thereof.

Appln. No. 10/065,970
Docket No. GEM-0066 / 126995

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 50-2401.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,

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